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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,974	06/08/2001	Tsuyoshi Komaki	209637US2	8334
22850	7590	05/21/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CAO, ALLEN T	
			ART UNIT	PAPER NUMBER
			2652	7

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,974

Applicant(s)

KOMAKI ET AL.

Examiner

Allen T Cao

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election with traverse of Group I, claims 1-3, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that "The claims of the present invention would appear to be part of an overlapping search area ... that a search and examination of the entire application would not place a serious burden on the Examiner". This is not found persuasive because Claims 1-3 are drawn to an optical information medium apparatus which is classified in class 369/283; on the other hand, claims 4-10 are drawn to a method for preparing an optical medium which is classified in class 158/275.3. These inventions are distinct for the above reasons and have acquired a separate status in the art as shown by their different classification; therefore, restriction for examination purposes as indicated is proper.

2. Claims 4-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

3. This application contains claims 4-10 are drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The requirement is still deemed proper and is therefore made FINAL.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishida et al (US. 6,349,086 B2) in view of either Yokoyama (US. 5,714,222) or Japan (3-88148).

Nishida et al disclose an optical information medium 1 having a disk shaped supporting substrate 2 having a center hole (inherently because all optical disc having a center hole), an annular information recording area thereon (6 includes the recording layer 4), and an annular resin based light-transmitting layer 5 (resin is disclosed in column 5, lines 43-44), the light-transmitting layer terminating at a radial inner periphery (column 5, lines 38-39) and an annular raised rim 5a, as set forth in claim 1.

Regarding claims 2 and 3, Nishida et al disclose that the annular raised rim 5a is 5 to 300 μ m higher than the nearby surface of the light-transmitting layer as set forth in claim 2 (column 6, lines 9-12); and the light-transmitting layer 5 has a thickness of 30 to 300 μ m as recited in claim 3 (column 5, lines 63-64).

Nishida et al do not disclose that the annular raised rim 5a is terminated at the inner periphery. Nishida et al only disclose that the annular raised rim 5a is terminated at the outer periphery.

Yokoyama discloses a disc 1 having a center hole 3; a disc substrate 2; a resin protective layer 5 and an inner periphery raised rim 9 (figure 3).

Japan ('148) discloses a disc (figure 1) having a disc substrate 1; a center hole and a reflective layer 5 including a raised rim is located at the inner peripheral of the disc (figure 1).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to relocate the raised rim of Nishida et al to the inner peripheral instead of the outer peripheral as taught by either Yokoyama or Japan ('148).

The rationale is as follows: One of ordinary skill in the art would have been motivated to relocate the raised rim of Nishida et al to the inner peripheral instead of the outer peripheral as taught by either Yokoyama or Japan ('148) to provide an optical disc that can be increased further in recording capacity and that has a light transmitting layer of optimum surface properties free to the utmost extent from the raised rim on its inner rim portion (instead of outer rim portion).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. De Graaf et al (US. 5,188,863), Nishida et al (US. 6,613,396 B1), Japan (5-159394), Japan (5-325287), Japan (8-77629), Japan (7-65526), and Japan (3-83238).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen T Cao whose telephone number is (703) 305-3796. The examiner can normally be reached on Mon - Thurs (7:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Allen Cao
Primary Examiner

AC
May 13, 2004